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al. (USP 6,353,445). Responsive thereto, Applicant filed an After-Final Response on March 27, 2003 detailing the misapplication of Babula et al. with respect to the present application. Specifically, Applicant succinctly pointed out that the present application was filed after November 29, 1999 and, as such, a rejection under 103(a) might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person pursuant to MPEP § 706.02(k). In the March 27, 2003 Response, Applicant clearly set forth why the rejection based on Babula et al. be removed because Babula et al. fails to qualify as prior art under § 103 since the reference is owned by General Electric Co., as is the current application. The Response clearly stated that the inventors were under a duty to assign their rights to the common assignee at the time the invention was made and, as a courtesy, referred the Examiner to Reel/Frame #011499/0198 of the Assignment Records database, which evidences the common ownership of the reference and the present application. Accordingly, Applicant requested that the rejection of claims 1-24 under § 103(a) be withdrawn.

In reply to Applicant's After-Final Response, the Examiner indicated that Applicant's remarks were considered but failed to "place the application in condition for allowance". The Examiner reached this conclusion because the assignment at Reel/Frame #011499/0198 "shows that at the date the assignment was recorded, which was on 22 January 2001, which was a year prior to the application being filed." (emphasis added) See Continuation Sheet of Advisory Action. The Examiner therefore concluded that "at the time the application was filed the record does not show that GE Medical Technology as being the assignee." Accordingly, concluded the Examiner, "Applicant's attempt to exclude Babula et al., U.S. Patent No. 6,353,445 under 35 USC 103 is not [be] sufficient enough to overcome the prior art rejection." The Examiner's conclusions, however, contradict the statute, the rules, and the Office's Manual of Patent Examining Procedure (MPEP).

MPEP §706.02(l)(2) provides that in order to be disqualified as prior art under 35 U.S.C. 103(c), the subject matter which would otherwise be prior art to the claimed invention and the claimed invention must be commonly owned at the time the claimed invention was made. See MPEP § 706.02(l) for 35 U.S.C. 102(f)/ 103 or 35 U.S.C. 102(g)/103 prior art disqualified under 35 U.S.C. 103(c). See MPEP § 706.02(l)(1) for 35 U.S.C. 102(e)/ 103 prior art disqualified under 35 U.S.C. 103(c). Moreover, "common ownership at the time the invention was made" includes

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actual ownership of the invention by the common assignee or a legal obligation by the inventor(s) of the application to assign both the subject matter and the claimed invention to the common assignee at the time the claimed invention was made. Satisfaction of either of these requirements is sufficient for the subject matter of the reference to be disqualified as prior art. See MPEP §706.02(I)(2)

It is irrelevant when the assignment was executed or recorded. In fact, according to MPEP § 706.02(I)(1), it is not even a requirement that the assignment ever be executed or recorded with the U.S. Patent and Trademark Office (USPTO). The only requirement is that there be an obligation by the inventors of the application, at the time the claimed invention was made, to assign the claimed invention to the common assignee. To meet this burden it is sufficient for the Applicant or its representative to simply state: "Application X and Patent A were, at the time the invention of Application X was made, owned by Company Z." MPEP § 706.02(I)(1) In the After-Final Response mailed March 27, 2003, Applicant noted that the reference and the present application were commonly owned by General Electric Co. and further stated that "inventors of the present invention were under a duty to assign their rights to the common assignee at the time the invention was made." The statements provided in the After-Final Response satisfy all the requirements set forth at MPEP §706.02(I)(2) with respect to the establishment of common ownership.

The undersigned, in a telephone interview with the Examiner on April 30, 2003, made attempts resolve this issue; however, the Examiner repeatedly indicated that the recordation date was relevant. As clearly set forth above, the recordation date is not relevant of an obligation to assign the claimed invention to the Assignee of the reference at the time the claimed invention was made. For these reasons, Applicant respectfully believes the Examiner has ignored the requirements of MPEP §706.02(I)(2) and that common ownership of the reference and the claimed invention at the time the claimed invention was made has been sufficiently shown. Accordingly, since the reference fails to qualify as prior art, any rejections relying thereupon must be withdrawn.

Therefore, in light of the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-24.

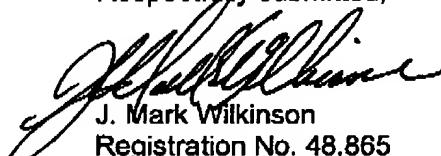
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For purposes of Appeal, Applicant requests an explanation as to why the Examiner indicated that Applicant's previous response of March 27, 2003 will not be entered. Applicant contends this issue is ripe for appeal and requests entry of its response for purposes of appeal.

Applicant appreciates the Examiner's consideration of these Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,



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